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Remarks:

Reconsideration of the application is requested.

Claims 1, 2, 7-12 and 17-20 remain in the application. The specification and Figs. 3 and 4 have been amended for clarification purposes that do not pertain to any of the objections or rejections given in the Office action. Support for the changes can be found on page 9, lines 11-13 of the specification. No new matter has been added.

It is noted that in item 1 on page 2 of the above-identified Office action, that the Examiner has reopened prosecution and given new grounds of rejection.

In item 2 on page 2 of the Office action, the Examiner has requested a copy of the article mentioned on page 2, lines 1-4 of the specification of the instant application. Enclosed herewith is a copy of the article "Elektrisch leitende Kunststoffe".

In item 3 on page 2 of the Office action, the drawings have been objected to.

More specifically, the Examiner stated that it is unclear how the conducting surface of the plastic member is disposed at a

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respective spacing distance from the contact pins, if the pins are embedded in the plastic member.

It is noted that page 9, lines 1-3 of specification discloses a plug-in connector with an additional conducting face or conductive surface 5, which is illustrated in Fig. 3. The conductive surface is in this case a metal foil. The specification further discloses that the voltage at which the material 21 becomes conductive can be set via the spacing d. The conductive surface 5 makes electric contact with a contact pin responsible for dissipating the electrostatic charge. Individual spacings d can be set between the contact pins 1 and the conductive surface 5 for the individual contact pins (page 9, lines 10-15). Figures 3 and 4 show the conductive surface or metal foil 5, and the different spacings d are shown as well. Therefore, the drawings have not been amended to overcome the objection to the drawings.

In item 5 on page 3 of the Office action, claims 7 and 12 have been rejected as being indefinite under 35 U.S.C. § 112.

It is noted that applicants believe that the Examiner actually meant to reject claim 2 instead of claim 7. It is noted that the comments provided below are with respect to claim 2.

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More specifically, the Examiner has stated that the drawing and the specification do not disclose how the conducting surface of the plastic member is disposed at a respective spacing distance from the contact pins. Furthermore, the Examiner stated that the Examiner assumes that the conducting surface is an electrically conductive plated which is attached to the rear side of the plastic member and there is a spacing distance between the plate and the pin. It is applicants' position that this is not an assumption and that the Examiner's comments are supported by the specification as noted above with regard to the objection to the drawings. Particularly, page 9, lines 1-3 of the specification discloses that a plug-in connector with an additional conducting face or conductive surface 5 is illustrated in Fig. 3. Therefore, claims 2 and 12 have not been amended to overcome the rejection.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved.

In item 7 on page 3 of the Office action, claims 1, 7-11, and 17-20 have been rejected as being obvious over Kinkaid (U.S.

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Patent No. 3,264,599) in view of Wanger et al. (U.S. Patent No. 5,280,467) (hereinafter "Wanger") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 11 call for, *inter alia*:

a plastic member including a material being a mixture of a plastic and a carbon powder, having conductive properties at voltages above a given working voltage range and having insulating properties at voltages in the given working voltage range.

In item 4 of the Office action, the Examiner stated that Kinkaid discloses a plug-in connector that lacks any features to prevent electrostatic discharge. The Examiner also stated that the plug-in connector taught by Kinkaid is susceptible to electrostatic discharge, which causes damage to sensitive electronic components during mating with the connector.

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Therefore, the Examiner applies the Wanger reference to solve the above-noted problem.

The Wanger reference discloses a housing of an optical disk. With regard to the technical field, such a housing has no relation to the subject matter of the instant application. The thermoplastic housing disclosed in Wanger has a ratio of 8-12% carbon powder or 20-30% carbon fibers. Even though the carbon added to the thermoplastic material serves to prevent electrostatic discharge, the use disclosed in Wanger is entirely different than that of the instant application. In an automatic changer for optical disks, the risk of errors caused by electrostatic discharge is to be minimized. Therefore, a person of ordinary skill in the art dealing with electrical plug-in connectors would not consult the Wanger reference, which pertains to a housing for optical disks.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art

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to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Kinkaid to incorporate the features of Wanger, and there is no teaching or suggestion in Wanger to incorporate the features of Kinkaid.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion,

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or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Kinkaid or Wanger or to combine Kinkaid's and Wanger's teachings to arrive at the claimed present invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Kinkaid or Wanger or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

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Since claims 1 and 11 are believed to be allowable dependent claims 7-10 and 17-20 are believed to be allowable as well.

In item 8 on page 4 of the Office action, claims 2 and 12 have been rejected as being obvious over Kinkaid (U.S. Patent No. 3,264,599) and Wanger (U.S. Patent No. 5,280,467) in further view of Bauer (U.S. Patent No. 5,161,991) under 35 U.S.C. § 103. Bauer does not make up for the deficiencies of Kinkaid and Wanger. Since claims 1 and 11 are believed to be allowable, dependent claims 2 and 12 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 11. Claims 1 and 11 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1 or 11, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1, 2, 7-12, and 17-20 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.




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If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,

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For Applicant(s)

AKD:cgm

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